

S/N 09/904,234

PATENTIN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Griseri et al.	Examiner:	Footland, Lenard
Serial No.:	09/904,234	Group Art Unit:	3682
Filed:	July 12, 2001	Docket No.:	9728.231US01
Title:	BEARING HUB UNIT FOR MOTOR VEHICLE WHEEL		

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CERTIFICATE UNDER 37 CFR 1.6(d): I hereby certify that this paper is being transmitted by facsimile to the U.S. Patent and Trademark Office on April 26, 2004

By: 
Name: Lisa Hill**RECEIVED
CENTRAL FAX CENTER**RESPONSE

APR 26 2004

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Office Action mailed on February 26, 2004, Applicant's respectfully request reconsideration of the application in view of the following remarks. Claims 1, 3, 4, and 5 are pending. Claim 5 was found to contain allowable subject matter in the Office Action mailed September 29, 2003. Applicants thank the Examiner for recognizing and noting that claim 5 contains allowable subject matter.

Claims 1, 3, and 4 were rejected under 35 U.S.C. § 102(a) as anticipated by Picca (U.S. Pat. No. 6,322,253). Applicants respectfully traverse this rejection. In the Examiner's response to Applicant's arguments on page 3 of the Office Action, the Examiner indicates that the rejection was based upon the portion of §102(a) which renders inventions unpatentable when they are "known or used by others in this country" before the invention thereof by the Applicant.

Picca Does Not Constitute Prior Art Under 35 U.S.C. § 102

According to MPEP § 2132, as used in §102(a) the phrase "'known or used by others in this country' means knowledge or use which is accessible to the public." (citing *Carella v.*

Starlight Archery, 804 F.2d 135, 231 USPQ 644 (Fed. Cir. 1986)). Thus, only knowledge or use which the public has access to can be used in support of a §102(a) rejection. Moreover, a patent application is not publicly known until the patent has been published, or has otherwise been disclosed to the public by the applicant for that patent. 35 U.S.C. §102(a) has a specific provision for patents and other printed publications. In order to constitute prior art under §102(a), the patent, or printed publication, must have been at least minimally available to the public. (MPEP § 2128). A patent is sufficiently available to the public if it is "laid open for public inspection or disseminated in printed form." (MPEP § 2126). If every patent application demonstrated public knowledge or use of an invention, the separate §102(a) provision addressing patents would be completely redundant and unnecessary. Moreover, a more specific provision controls over a more general provision. Thus, the more specific, patent and printed publication provision applies to a patent application rather than the more general provision addressing public knowledge or use. In addition, only knowledge or use in the United States is relevant to §102(a).

The Picca reference was filed on February 24, 2000, but did not issue until November 27, 2001. A patent application is secret until it is published or the applicant thereof has otherwise publicly disseminated the invention. The Examiner has not provided any evidence that the currently claimed invention was known or used *by the public* prior to the date which the current application was filed. The mere filing of a patent application does not demonstrate that an invention was known or used in a manner *accessible to the public*, as is required under §102(a). Accordingly, the Applicants respectfully contend that Picca does not constitute prior art under 35 U.S.C. § 102(a).

Moreover, when presented with two inconsistent provisions, the more specific provision controls over the more general provision. The Examiner relies upon a filed patent application in support of the §102(a) rejection. Accordingly, the patent and printed publication provision controls over the more general, publicly known or used, provision. A patent application constitutes prior art under § 102(a) only after it has either been published, issued, or otherwise made accessible to the public. Since there is no evidence that the Picca patent application was accessible to any member of the public before Applicant's filing date, Picca cannot be considered prior art for §102(a) purposes. *See Carella v. Starlight Archery*, 804 F.2d 135, 231 USPQ 644

(Fed. Cir. 1986). Accordingly, for at least this reason as well, Applicants respectfully contend Picca cannot anticipate claims 1, 3, and 4.

Picca Fails to Anticipate Claims 1, 3, and 4

Claim 1 requires a bearing having a radially outer rotating ring that is mounted in the cylindrical axial seat of an annular hub for rotating fast with the annular hub.

Picca is directed to a bearing assembly which is attached to a strut. Picca teaches that the outer bearing is fixed to the strut. (Abstract; Col. 2, ll. 56-64; Claim 1). For this reason, the outer ring of the bearing taught by Picca must be stationary, and cannot rotate. Thus, Picca fails to teach a bearing having a radially outer rotating ring that is mounted in the cylindrical seat of a hub. Accordingly, the Applicants respectfully contend Picca fails to anticipate claim 1.

Claims 3 and 4 depend from claim 1, an allowable base claim. For at least this reason, Picca fails to anticipate claims 3 and 4.

In view of the above, Applicant respectfully requests reconsideration of the application in the form of a Notice of Allowance.



Date:

April 24, 2004

Respectfully submitted,

MERCHANT & GOULD P.C.
P.O. Box 2903
Minneapolis, Minnesota 55402-0903
(612) 332-5300

By:

John J. Gresens
John J. Gresens
Reg. No.: 33,112
JJG/TSW

Merchant & Gould

An Intellectual Property Law Firm

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3200 IDS Center
80 South Eighth Street
Minneapolis, Minnesota
55402-2215 USA
TEL 612.332.5300
FAX 612.332.9081
www.merchant-gould.com

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TO: Commissioner for Patents
Attn: Examiner Lenard A. Footland
Patent Examining Corps
Facsimile Center
Washington, D.C. 20231

FROM: John J. Gresens

OUR REF: 9728.231US01
TELEPHONE: 612.371.5265

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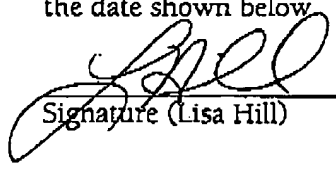
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